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| 10/763,638   | 01/23/2004  | Shridhar P. Joshi    | 247079-000225USP1              | 7736                   |
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| NIXON PEABODY LLP<br>300 S. Riverside Plaza<br>16th Floor<br>CHICAGO, IL 60606 |             |                      | EXAMINER<br>HYLINSKI, STEVEN J |                        |
|  |             |                      | ART UNIT<br>3714               | PAPER NUMBER           |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/763,638  
Filing Date: January 23, 2004  
Appellant(s): JOSHI ET AL.

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Wayne L. Tang  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/14/2010 appealing from the Office action mailed 04/21/2009.

**PRELIMINARY REMARKS**

After further consideration, this application contains at least one claim that does not meet the patent eligibility requirement for statutory subject matter under 35 USC 101. Accordingly, this examiner's answer contains a new ground of rejection under 35 U.S.C. 101. Appellant must within **TWO MONTHS** from the date of this answer exercise one of

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the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

There are no related appeals or interferences.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed upon appeal is substantially correct. The changes are as follows: Claim(s) 1-11 and 28 are rejected under 35 USC 101 as being directed to non-statutory subject matter.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

|              |          |         |
|--------------|----------|---------|
| 6,309,300    | Glavich  | 10-2001 |
| 6,186,894    | Mayeroff | 2-2001  |
| 2004/0166918 | Walker   | 8-2004  |
| 2003/0064807 | Walker   | 4-2003  |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**NEW GROUND(S) OF REJECTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim(s) 1-11 and 28 are rejected under 35 USC 101 as being directed to non-statutory subject matter** because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v.*

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Flook, 437 U.S. 584, 588 n.9 (1978) (citing Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). See also In re Bilski (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101. Specifically, independent claims 1 and 28 recite a wagering game in the preamble but do not require the method steps be implemented by any particular machine. Neither do the claims require that the method transform a particular article. Dependent claims 2-11 do not remedy the statutory deficiencies of independent claim 1 and fall under the same rejection.

## **PREVIOUS, MAINTAINED GROUNDS OF REJECTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-2, 4-5, 7, 9, 29, 31-32, 34, and 36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 6,309,300 to Glavich.**

### **Re Claims 1, 9, 29, 36**

Glavich discloses a method for playing a wagering game having a special payout, the method comprising: presenting a basic game (Abstract, a main game) having a plurality of randomly selected outcomes being selected independently of player selection, the randomly selected outcomes including a special-payout outcome (Fig. 1 shows the main game being a 3 reel slot game and Fig. 1 **132** shows winning symbol

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combinations in a pay table. Spinning slot reels, initiated by the player pulling a handle (Col. 2 Lines 65-67) to obtain outcomes compared against a pay table (Col. 3 Lines 3-4), means that the player is not directly selecting the reel outcomes. Both base game slot reel combinations and bonus game picks are randomly selected by the computer, not directly by the player. Fig. 2 blocks **234-236** show that the determination of which selectable bonus game objects will cause a bonus game selection win, i.e. a special-payout outcome, is randomly selected. Col. 3 Lines 5-33 clarifies that the step of associating selectable bonus game items with prizes is performed by microprocessor **412**, not the player.); accepting a basic wager from a player for the basic game between a minimum and maximum amount (Fig. 2, a wager is received for the main game in block **212**. Col. 3 Lines 65-67 and Col. 4 Lines 1-2 disclose that optionally, the game may allow the player to make “an additional wager or side wager related to the bonusing feature”.) presenting an additional, separate side-wager option for a player to place an additional side-wager distinct from the accepted basic wager, the side-wager option requiring a side-wager amount in addition to the accepted basic wager (Again see Col. 3 Lines 65-67 and Col. 4 Lines 1-2); in response to a player not choosing the side-wager option, providing the player with a first probability greater than zero of achieving the special-payout outcome (Columns 3 and 4 disclose that in the selection-type bonus game, the number of items associated items associated with the number of selectable items, or in other words the number of selectable items “M” that will cause a winning bonus outcome when selected by the player, can be varied based on the same factors that “N” can be. As discussed in Col. 3 Lines 65-67, “N” can be based on the side

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wagers related to the bonusing feature. Hence "M" can be selected based on the side wager related to the bonusing feature as well. Specifically, Col. 3 Lines 65-67 and Col. 4 Lines 1-2 state that "in some embodiments the player may be given an option to make an additional wager or side wage related to the bonusing feature, e.g., for the purpose of increasing the value of N." Col. 5 Lines 26-42 then expounds on this concept, stating that "The M items are selected or calculated 232 in any number of fashions. In other embodiments, the M associated items may be selected using factors similar to those described above in connection with selection of the value N [...] including selecting based on the amount of wagers [...] The values of Z and N, and the items which are associated with some or all of the N selectable items, all affect the amount of bonusing prizes, averaged over a period of time.") in response to the player choosing the side-wager option, providing the player with a second probability of achieving the special-payout outcome, the second probability being greater than the first probability (see discussion above, the number of selectable items N having "associated items M", can be increased based on a side wager, for the purpose of "affecting the amount of bonusing prizes averaged over a period of time"); conducting the basic game with the first probability if the player does not choose the side-wager option (it inherent that if a side wager is not chosen, the game will be conducted according to the base wager required to play the game (**212** in Fig. 2), or the second probability if the player chooses the side-wager option (increasing the number of selectable bonus objects that will result in winning bonus picks (special-payout outcomes), based on a side wager); and in response to conducting, crediting the player the special payout when the special-payout

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outcome occurs in the basic game (Col. 6 Lines 37-39, if a selectable bonus item has a prize associated with it, the prize value increments on the player's machine).

**Re Claims 2, 5, 7, 32, 34**

The base game is shown in Fig. 1 as being a slot machine having traditional symbol-bearing reels. **132** shows a typical slot machine pay table for different base game outcomes that can occur.

**Re Claims 4 and 31,**

Glavich discloses that the associated items associated with some of the player-selectable items can be "additional plays of the main game". A free play of a main game constitutes a "bonus game" in the art of electronic casino gaming.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3, 12-13, 15-16, 18, 23, 25, 27-28, 30, and 37 are rejected under 35 U.S.C.**

**103(a) as being unpatentable over Glavich.**

**Re Claims 3, 23, and 30,**

Glavich discloses in Col. 4 Lines 44-52 that the associated items associated with the player-selectable items of the bonus game can include monetary prizes. Glavich thus obviously encompasses providing progressive monetary prizes as associated items.



**Re Claims 12, 25, and 27-28, and 37**

Glavich discloses that there are various types of associated items that can be associated with the user-selectable items in a bonus round. For example see Fig. 1, in which five user-selectable items are shown. Each of these user-selectable items may, or may not, have one of various types of associated items associated with it. Glavich discloses in Col. 4 Lines 44-67 and Col. 5 Lines 1-16, what some of these types of associated items may be, such as multipliers, bonus prize values, demerits, free plays, etc. Glavich also discloses in Col. 5 Lines 28-38 that the associated items can be selected based on "factors similar to those described above in connection with selection of the value N" including "selecting based on the amount of wagers". We know from the discussion above that the "factors similar to those described above in connection with selection of the value N" also include "additional or side wagers". One of skill in the art would recognize that a system in which the types of hidden prizes associated with user-selectable items can be varied based on side wagers and additional wagers" would obviously encompass varying the types of hidden prizes when a max wager occurs, because a max wager is the highest form of an "additional wager". Because Glavich states that the items can be varied based on such factors as varying wager types or amounts, and because many different types of functions that can be associated with the items exist in his system, such as bonus values, free plays, multipliers, etc., more than one type of award could be obtainable only when a max and/or side wager is selected, and not available when a max and/or side wager is not selected. For example, Glavich's system obviously encompasses the possibility of having a first payout of multiplier

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functions, and a second payout of free games, when a max wager or side wager have been utilized, but neither being available when a max wager or side wager has not been utilized.

**Re Claim 13,**

See the rejections of claims 3 and 4 above.

**Re Claim 15,**

Glavich has disclosed, as discussed above, that his system is capable of allowing the user to select side wagers, and/or wagers otherwise increased above the base level. Therefore Glavich's system must have some sort of user input devices in order for his system to be functional. These selections must be in the form of mechanical buttons, as are old and well-known in the art, or in the form of other I/O features such as icons on a touch screen, which would also meet the limitation of buttons. Glavich discloses that although a keypad can be used to enter wagers, "other components such as buttons, [or] touchscreens and the like can also be used." (Col. 2 Lines 66-67 and Col. 3 Lines 1-2.

**Re Claim 16 and 18,**

See the rejection of claim 2 above.

**Claims 6, 17, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich, in view of US 6,186,894 to Mayeroff.**

**Re Claim 6, 17, and 33,**

Glavich shows in Fig. 1 that his base game can be a slot machine having traditional symbol-bearing reels. However, Glavich is silent on the symbols on the reels being able to include symbols from a deck of playing cards.

The Mayeroff reference was discussed in the previous Office Action, the discussion of which is incorporated by reference herein. Mayeroff teaches an analogous gaming machine having a slot machine base game, in which the symbols on the reels can be any symbols representing a common theme" (See Col. 6 Lines 47-54 of Mayeroff).

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, that incorporating the well-known teaching of Mayeroff regarding what types of symbols can be used on slot reels, into Glavich's analogous slot reel base game, would yield predictable and non-inventive results.

**Claims 8, 10-11, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich, in view of US 2004/0166918 to Walker.**

**Re Claims 8, 10-11, and 35,**

Glavich's invention, which has the purpose of altering the probability of achieving a winning bonus pick (special-payout outcome) to a player based on changing the number of wins associated with a plurality of symbols, is applied to a selection-type bonus game in the exemplary embodiment. However, one of skill in the art would readily be able to apply the same teaching of altering the number of winning symbols among a group of selectable game symbols, into a slot reel game, because the same result of the game controller being able to selectably alter the bonus payout to a player over a period

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of time, would remain the same, and also because applying Glavich's teaching to slot reels would not create any results outside of what would be expected by one of ordinary skill in the art. Walker, in fact, discloses a method an apparatus for changing the number of winning symbols on slot reels in order to modify the payout (Walker Paragraph 24, wherein the "game play parameter" includes the number of symbols on each reel, and the probability of the character appearing on a given handle pull.

Paragraphs 103-104 of Walker further state that the gaming device, or the casino controlling it, can vary the game play parameters during play to control the number of bonus symbols on each reel which initiate a bonus round".) Thus it is known in the art how Glavich's invention could be readily applied to slot reels. At the time the invention was made, it would have been obvious to one having ordinary skill in the art that applying Galvich's teaching of modifying the number of symbols associated with a bonus outcome, to slot reels, as Walker discloses is known, would have predictable and non-inventive results.

**Claims 19-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich, in view of US 2003/0064807 to Walker.**

**Re Claim 19,**

Glavich discloses that the gaming terminal has the two options of being available for the special payout, those two options being the max wager and side wager discussed in the rejection of claim 12 above. Glavich also discloses the gaming terminal having signage located above and coupled to the gaming terminal, the signage displaying the special payout and for receiving a signal that the gaming terminal is

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eligible to win a special payout (See Col. 3 Lines 5-30 of Glavich, in which he discloses that the display that is used to provide the base and bonus games of the instant invention, the bonus game including the modifiable outcomes that can be based on whether a side wager or other type of additional wager including a max wager has been selected, as discussed in the rejection of claims 1 and 12 above). Glavich states that the gaming machine used in his device may have “a communication device” for remote accounting purposes. Glavich also states that “the present invention can also be implemented in many other types of gaming devices (Col. 2 Lines 53-55”. However, Glavich is silent on the gaming device being linked with other gaming devices.

Walker discloses an analogous system comprising networked casino gaming devices for playing games of chance including slot games and card games (Abstract and Paragraph 42). Walker teaches the plurality of casino gaming machines (Fig. 1A, gaming devices **104, 106, 108**) being in combination with at least one other gaming terminal (Fig. 1A, the gaming devices are networked) for conducting wagering games (Paragraph 42), the gaming terminals and the signage being a gaming system (each of the gaming devices (Fig. 1A and Paragraphs 30-32, a system for linked game play wherein players can compete as a group or against each other, and Paragraph 50, wherein each of the gaming devices has one or more video output devices).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have incorporated Walker's teaching of a single gaming machine being used in a network in order to interact with other gaming machines, into the slot machine with bonusing taught by Glavich, because networked game play is old

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and well-known in the art, and also because many gamblers enjoy the social interaction that linked gaming provides (Walker, Paragraph 16).

**Re Claims 20-21,**

Glavich's gaming devices having an output device controller for controlling their output device(s) for controlling a bonus outcome, the output device controller being controlled by a gaming terminal controller (See Glavich Fig. 4, Microprocessor **412** controls the I/O device such as the Touchscreen **416**).

**Re Claim 22,**

Glavich in view of Walker further teach a gaming system, wherein each of the plurality of gaming terminals are identical machines (Walker Paragraph 42, the gaming machines can be any gaming machine, including slots, poker, etc. Because each gaming machine can be any of the disclosed gaming machines, the system is inherently capable of supporting all of the machines being the same machine).

**Re Claim 24,**

Glavich discloses that his system can have bonus prize values associated with user-selectable items in his bonus game (Col. 6 Lines 37-40).

**(10) Response to Argument**

As a preliminary matter, Appellant appears to have made a typographical error in line 2 of page 10 of the Appeal brief filed 04/14/2010. Examiner believes the sentence should instead read "both the base game and *bonus* game described in Glavich" rather than "the base game and base game" that Appellant's sentence reads as-presented.

**A. Claims 1-2, 4-5, 7, 9, 29, 31-32, 34, 36**

**1. The claimed term “basic game” is a nonspecific statement of intended use that the entirety of Glavich’s base game plus bonus game system does meet**

Examiner maintains that the term “basic game” in the instant claims is merely a statement of intended use that is met by Glavich’s system of a base game in conjunction with a bonus game, because there is no specific structure spelled out by the claimed basic game that any part of Glavich specifically lacks. What Appellant chooses to name certain game components absent any difference in structure, does not affect patentability. The term “basic” game, minus any explicit, special purpose definition in the specification, is a label of intended use that does not provide any guidance on what would not suffice as a basic game. Any game meeting the limitations of the instant application claims can be interpreted as a basic game meeting these limitations. Examiner further notes that the term “basic game” used in the instant claims does not carry any special meaning in the art of electronic casino gaming machines. It is normal to term a first part of a multiple-phase or multiple-round casino game a “base game” or “primary game” and then term successive phases or rounds of the same game a “bonus” or “secondary” game (although even then, which part of a game is base vs. bonus or primary vs. secondary is somewhat arbitrary).

Appellant’s argument presented on page 11 of the Appeal Brief that the bonus game features of Glavich can not be applied to teach a “basic game”, is therefore moot because both the base and bonus game features of Glavich can fall under the umbrella of the intended use of a “basic game”.

**2. Glavich does teach a “basic game” with a random outcome including a Special-Payout selected independently of Player selection.**

Appellant's argument directed to the concept of random, independent player selection appears to be based on a misreading of the Office Action. Examiner is not interpreting bonus round picks of Glavich, made by the player, as randomly, independently selected. The Final Office Action of 04/21/2009 clearly indicates that the picks made in the primary and bonus games, by the gaming system and not by the player, are the random, player-independent selections including a special-payout outcome. These random, player-independent selections of Glavich include the slot reel symbols selected by the slot reel primary game, with the symbol combinations of the reels evaluated against a pay table as is notoriously well-known in the art (see Col. 3 Lines 3-4 and Col. 3 Lines 20-25 of Glavich, which describe the structure for having pay tables associated with the primary slot game as shown in Fig. 1. The pay table is No. 132 and slot reels are No. 114), and the bonus game picks also as random outcomes (which of the selectable objects in the bonus game, is awarded a prize value that is deemed as being won when the player selects the corresponding object, is randomly determined in block No. 236 of Fig. 2 of Glavich).

**3. Glavich anticipates a Special Payout in accordance with Claims 1 and 29**

Examiner interprets a special-payout as the occurrence of a bonus game granted to a player, when triggered from the primary slot reel game of Glavich. A special-payout outcome, then, is a winning selection made in the bonus game. As discussed earlier, the base and bonus game of Glavich, overall, can be viewed as a “basic game”.



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Examiner disagrees with Appellant's allegation that the opportunity to play a bonus game granted to a player as the result of a primary game outcome, does not meet the definition of payout. A payout is the awarding of any prize of perceived value. In the case of Glavich winning the play of a bonus game would provide perceived value to the player, as the player will be given the opportunity to win further prizes than were awarded in the primary game, as is notoriously well-known in the art. Appellant's argument that there is no guaranteed award in the bonus game is irrelevant because Examiner interprets the occurrence of the bonus game itself as a payout. Any prizes won in the bonus game were repeatedly and explicitly called out by Examiner in Office Actions including the Advisory Action dated 0723/2009, as being winning outcomes of the bonus round. Appellant's argument over the order of play in Glavich (primary game before bonus game) is beyond the scope of the claims. Appellant repeatedly treats the claim limitation of "basic game" as if it was awarded some special purpose definition, yet this is not the case.

**4. Glavich anticipates conducting the basic game with different probabilities in accordance with Claims 1 and 29**

As discussed by Examiner above, there is nothing about the claims or specification of the instant application that precludes Examiner from awarding the entire game of Glavich consisting of base and bonus game components, the label of "basic game" because there is no structure associated with this name that the base plus bonus game of Glavich lacks.

Glavich provides more than one probability of winning a prize in a bonus game based on the side wager (special payout outcome) in this way: In Fig. 2 of Glavich, a base wager is made, and Col. 3 Line 65-Col. 4 Line 2 states that in addition to this base wager a side wager may be made. Columns 3-4 state that the number "M" of selectable bonus game outcomes associated with a favorable result can be based on the amount of the side wager made in addition to the base wager. Although the side wager of the base game in Glavich affects the probability of achieving a winning special payout outcome in the *bonus game* of Glavich as pointed out by Appellant, the bonus game still falls under the umbrella of a "basic game" along with the base game as already pointed out by Examiner. What Appellant chooses to name certain game components absent any difference in structure, does not affect patentability.

**B. Claims 3, 12-13, 15-16, 18, 23, 25, 27-28, 30, and 37**

**1. Glavich teaches a basic game with a Random Outcome selected independently of Player Selection and a Special Payout**

Aside from Appellant's continued allegation that the name "basic game" precludes Glavich's base-plus-bonus game from anticipating the same structural limitations, Appellant provides no proof beyond a mere statement of opinion that he believes Glavich does not teach outcomes selected independently of player selection. Page 4 of the Final Office Action mailed 04/21/2009 states that the spinning reel slot machine which selects outcomes, including bonus game objects, is the means by which random outcomes (slot reel symbols) are selected that include non-special payout outcomes, and Col. 3 Lines 5-33 states that the step of determining which associated

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selectable bonus game items have prizes (special payout outcomes), is performed by the microprocessor **412**, not the player, hence independent of player selection.

**2.** Claims 12, 25, and 28 require the gaming terminal to not award a first or second payout based on a corresponding first side wager or a second max wager. In other words, if a player makes a wager on a basic game that does not include a side wager or max wager, the player will not receive payouts reflecting a side or max wager. Examiner addresses this feature in the rejection of claims 12, 25, 27-28, and 37 in the Final Office Action, Citing Col. 4 Lines 44-Col. 5 Line 16 and 28-38. In these sections Glavich lists various alterations that may be made to payouts based on side or max wagers. If the side or max wagers are not made, these alterations (first and second payouts in accordance with a first side wager or second max wager) will not be applied.

**C. and D. (1): Re Claims 6, 8, 10-11, 17, 33, and 35:**

These claims depend from claims 1, 10, and 29 and are not argued separately by Appellant, but will fall in accordance with the above discussion of claims 1, 10 and 29.

**D. Claims 8, 10-11, 35**

**2. Progressive Game Payout**

Appellant's argument against the obviousness rationale used against claims 3, 10-11, and 25, of a progressive payout useable in Glavich is improper because, due to Appellant's failure to traverse the common knowledge in the art statement Examiner presented previously in the Non-Final Office Action of 10/14/2008 and the Final Office Action of 04/21/2009, the statement became admitted prior art in accordance with MPEP 2144.03. When applicant does not traverse the examiner's assertion of official

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notice or applicant's traverse is not adequate, the common knowledge or well-known in the art statement is taken to be admitted prior art. For the above reasons, it is believed that the rejections should be sustained.

#### **E. Claims 19-22, 24**

These claims are not argued separately by Appellant and will fall in accordance with the above discussion of claim 12.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

#### **(12) New Grounds of Rejection**

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

**(1) Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

**(2) Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

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rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/STEVEN J HYLINSKI/

Examiner, Art Unit 3714

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

/Robert P Olszewski/

Director, Technology Center 3700

Conferees:

/Dmitry Suhol/

Supervisory Patent Examiner, Art Unit 3714

/Michael J Milano/

Primary Examiner